

Attorney Docket No.: ISPH-0613  
Inventors: Crooke et al.  
Serial No.: 10/054,313  
Filing Date: October 22, 2001  
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#### REMARKS

Claims 1-45 are pending in the instant application. Claims 1-13 and 20-43 have been withdrawn from consideration. Claims 14-19 and 44 have been rejected. Claim 45 has been objected to. Claims 1-44 have been canceled. Claim 45 has been amended. New claim 46 has been added in incorporate subject matter from canceled claims. Support for the matter encompassed by this new claim can be found at pages 11 through 15 of the specification as filed. No new matter has been added by these amendments or additions to the claims. Reconsideration is respectfully requested in light of these amendments and the following remarks.

#### I. Restriction Requirement

The Restriction Requirement wherein claims 1-13 and 20-43 were placed into Group I, and claims 14-19, 24-26, 44 and 45 into Group II, has been deemed proper and made Final, except that claims 24-26 have been placed into Group I and thus are no longer a part of Group II. Accordingly, Applicants have canceled claims 1-13 and 20-43 without prejudice, reserving the right to file continuing applications on the canceled subject matter.

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## II. Rejection of Claims Under 35 U.S.C. 112, First Paragraph

Claims 14-19 and 44 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art, at the time the application was filed, that the inventor had possession of the claimed invention. The Examiner suggests the specification is not enabling for any and all human RNase H sequences as there are numerous isoforms while the specification only teaches the human RNase H of SEQ ID NO: 1. Applicants have canceled claims 14-19 and 44. Withdrawal of this rejection is respectfully requested.

## III. Double Patenting

Claims 14-19 have been rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1-5 of U.S. Patent 6,001,653. The Examiner suggests that although the conflicting claims are not identical they are not patentably distinct from each other. Claims 14-19 have been canceled. Withdrawal of this rejection is respectfully requested.

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#### IV. Objection to the Claims

Claim 45 has been objected to as being dependent from a rejected base claim but the Examiner suggest it would allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended claim 45 to make it an independent claim. Withdrawal of this rejection is respectfully requested.

#### V. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

  
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